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10/786,185	02/25/2004	Cecile Drogou	2092.PKG	2385

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Cynthia L. Foulke
NATIONAL STARCH AND CHEMICAL COMPANY
10 Finderne Avenue
Bridgewater, NJ 08807-0500

EXAMINER

SZEKELY, PETER A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/786,185
Filing Date: February 25, 2004
Appellant(s): DROGOU ET AL.

Cynthia L. Foulke
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/11/08 appealing from the Office action mailed 3/9/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,239,208	Halloran et al.	5-2001
6,593,407	Haner et al.	7-2003
US 2002/0146526	Haner et al.	10-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 6-9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halloran et al. 6,239,208, Haner et al. 6,593,407 or Haner et al. 2002/0146526.

Halloran et al. disclose a hot melt composition containing at least one ethylene copolymer in claim 1, paraffin wax in claim 2, at least one tackifier in claim 3, ethylene n-butyl acrylate in claim 6 and a blend of rosin derived tackifier and aromatic tackifier in the paragraph overlapping columns 7 and 8. Haner et al. ('407) teach hot melt adhesive and modified rosin in claim 1, wax in claim 4, ethylene copolymer in claim 5, ethylene n-butyl acrylate in claims 6 and 7, paraffin wax in claim 10, processes and methods in claims 15 and 16 and blends of rosin and terpene tackifiers in column 1, lines 47-55, column 2, lines 41-48 and column 4, lines 52-54. For articles and frozen food containing articles see column 8, lines 42-61. Haner et al. ('526) is similar to the ('407) patent, but additionally in claims 15-20, packaged articles are shown. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to select applicants' ingredients from a list of equivalents.

(10) Response to Argument

Halloran et al. claim ethylene n-butyl acrylate as the at least one ethylene copolymer in claim 6 as part of a Markush group. This is equivalent with the copolymer being individually claimed. From column 4, lines 3, to column 5, line 5, all the polymers usable in the adhesive of Halloran et al. are described. While EVA is the preferred

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copolymer, it is well settled that a reference must be considered in its entirety and that the disclosures of a reference are not limited to the preferred embodiments or working examples. See *In re Kohler*, 177 USPPQ 399, 400 (CCPA 1973); *In re Fracalossi*, 215 USPQ 569, 570 (CCPA 1982). The claimed 110°C application temperature is inherent in the composition. In column 10, lines 15-17 an “application temperature of 120°C or less” is listed. The Haner et al. documents definitely claim ethylene n-butyl acrylate copolymer both by itself (claim 6) and with EVA (claim 12). Ethylene n-butyl acrylate is particularly preferred (column 5, lines 40-43). While blending it with EVA is most preferred, it does not mean the *In re Kohler* or *In re Fracalossi* do not apply here.

“Modified rosin and/or modified terpene” means either rosin or terpene or both.

Terpene-phenolics (column 4, lines 1-2) are aromatic. Claim 10 clearly claims either paraffin or microcrystalline wax. An application temperature below 130°C is shown in column 8, lines 35-36. The contents of the other Haner et al document are similar.

Since applicants claimed low application temperature hot melt adhesive is clearly dependent of using ethylene n-butyl acrylate with paraffin wax and a blend of tackifiers, it is evident that any other composition containing the same ingredients would have the same properties. The maxim that a compound and its properties are one and the same thing as a matter of patent law applies in this situation. *In re Papesch*, 137 USPQ 43, 51 (CCPA 1963). Applicants’ “comprising” language does not exclude other ingredients like flame-retardants.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Peter Szekely/

Primary Examiner, Art Unit 1796

Conferees:

/Harold Y Pyon/

Supervisory Patent Examiner, Art Unit 1796

/Gregory L Mills/

Supervisory Patent Examiner, Art Unit 1700